

Ex. Amort. C/KR
11/4/07

Notice of Allowability

Application No.

09/658,302

Examiner

Kartic Padmanabhan

Applicant(s)

BATEMAN, PAUL

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to September 20, 2001.
2. ☒ The allowed claim(s) is/are 1-4, 7-10, 12-31, 45, and 52-59, now renumbered as claims 1-37.
3. ☒ The drawings filed on 08 September 2000 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☒ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the top margin (not the back) of each sheet. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) ✓✓ | 4 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>12</u> . |
| 5 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. <u>4, 11</u> . | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

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DETAILED ACTION

Priority

1. Receipt is acknowledged of a certified copy of the Great Britain application referred to in the oath or declaration. If this copy is being filed to obtain the benefits of the foreign filing date under 35 U.S.C. 119(a)-(d), applicant should also file a claim for such priority as required by 35 U.S.C. 119(b). In the present case, applicant has not indicated in the priority column of the oath if priority is desired.

Specification

2. The abstract of the disclosure is objected to because it does not appear on one page. Correction is required. See MPEP § 608.01(b).

EXAMINER'S AMENDMENT

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Wes Musselman on November 2, 2001.

The application has been amended as follows:

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- ✓ 1) Original claim 5 was cancelled by pre-amendment A and remains cancelled.
 - ✓ 2) In claim 1, line 6, insert --only-- before "said opposed surface" and replace "is placed in" with --maintains--.
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✓ 3) In claim 1, line 7, insert --only-- before "said opposed surface" and replace "the outlet side" in line 8 with --an outlet side--.

✓ 4) In claim 13, replace "apparatus" in line 2 with --filter--.

✓ 5) In claim 14, line 2, delete "is/are adapted to" and replace "generate" with --generates--.

✓ 6) In claim 15, delete --can-- in line 2 of the claim.

✓ 7) In claim 16, line 2, replace "detectable using" with --detected using--.

✓ 8) In claim 19, line 3, replace "can bind" with --binds-- and "being" with --are--.

✓ 9) In claim 29, delete "adapted to visually detect a pH change".

10) In claim 45, replace step a) with 1a) providing the apparatus of any one of claims

1 to 36.

✓ 11) In claim 45, insert --of the sample separation filter-- after "surface" in step b.

✓ 12) In claim 45, in step c, insert --non-sample-- before "liquid".

✓ 13) In claim 45, in step c, replace "second" with --opposing-- and insert --of the sample separation filter-- after "surface".

✓ 14) In claim 45, in steps d and e, insert --non-sample-- before "liquid".

✓ 10) In claims 55-57, delete "non-motile spermatozoa and".

✓ 11) Add the following two new claims:

58. An apparatus according to claim 1, wherein the sample additionally comprises spermatozoa with reduced motility.

59. An apparatus according to claim 10, wherein the filter has a thickness of about 600uM.

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Allowable Subject Matter

4. Claims 1-4, 7-10, 12-31, 45, and 52-59, now renumbered as claims 1-37, are allowed.

5. The following is an examiner's statement of reasons for allowance: The closest prior art of record fails to teach or disclose an apparatus and method for separating motile spermatozoa from non-motile spermatozoa in which a filter, only when its opposed surface is maintained in contact with a non-sample liquid, prevent flow through of the sample but allows motile spermatozoa to flow through.

Claims 1-4, 7-10, 12-31, 45, and 52-59, now renumbered as claims 1-37, are thus novel and unobvious over the prior art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Claims 1-4, 7-10, 12-31, 45, and 52-59, now renumbered as claims 1-37, are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kartic Padmanabhan whose telephone number is 703-305-0509. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-5207 for regular communications and 703-305-3014 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Kartic Padmanabhan
Patent Examiner
Art Unit 1641

*** *KB*

November 5, 2001



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

11/06/01

